

Application of: Ko-Pen Wang
Serial No.: 10/693,645
Filed: October 27, 2003
Reply to Office Action of January 24, 2006

REMARKS/ARGUMENTS

The undersigned would first like to express thanks to Examiners Apanius and Hindenburg for conducting an interview in this application. The invention was discussed during that interview along with Dr. Wang's prior inventions, as well as a description of how the present invention is used.

The noted portion of the specification has been corrected, as suggested, as well as the abstract, and approval thereof is also respectfully requested.

By way of this Response, claims 8-11, 15, 16, 19 and 24-26 have been cancelled and claims 1, 4-7, 12, 14, 17, 18 20, 21, 23 and 27 have been amended. It is believed that the amendments fully correct the rejections made under 35 U.S.C. § 112 and withdrawal of those rejections is respectfully requested.

Claims 1-9, 12, 14-17, 19-24, 27-31 and 33-35 were rejected under 35 U.S.C. § 102 as being anticipated by Wang, U.S. Patent No. 4,966,162 (hereafter '162). This rejection is traversed and is not believed to be well founded.

As was discussed at the interview, this invention allows the outer needle section to be extended beyond the end of the device thereby providing a section of that needle which can penetrate the lung tissue and remain in place as the inner needle, attached to the distal end of the stylet, is thereafter repeatedly moved between its first and second extended positions to retrieve tissue samples in the same place in a tumor located opposite where the outer needle is positioned.

The stated basis for the rejection is incorrect in several respects as to what the '162 patent shows. First, with reference to Fig. 12, the '162 patent does not show first and second extended positions for the inner needle 256. That needle is under the control of the stylet 250 that extends all the way back to end cap 126 which controls the inner needle 256. As the '162 specification states, closing end cap 124 places spring 252 under

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compression (col. 10, lines 32-33) and with the end caps 124 and 126 connected together the inner needle 256 will then extend out beyond the distal end of needle 254. But with the end caps 124 and 126 locked together there is no longer an ability to push inner needle 256 further outwardly. (See col. 10, lines 38-43).

The '162 patent does not attach the spring 252 to the stylet as the Examiner states on page 3 of the Action. Rather, the stylet moves freely through spring 252 (See, Col. 10, lines 4-7).

Next, since the inner needle 256 only extends beyond the outer needle 254 as in Fig. 12, there is no "second length" for the inner needle, nor is there any "second length...longer than the first length."

These errors, however, serve to point out the differences between the invention here and in the '162 patent. Most significant is the ability to use the spring to move the inner needle independently of the outer needle, while using the same spring to hold the outer needle in place, and to do that by attaching the inner needle to the stylet that is also attached to the spring. That arrangement permits the outer needle to be held in place by the spring yet uses additional residual compressibility of that same spring to provide additional movement of the inner needle.

Claim 1 states that the outer needle is extended but nowhere states that the outer needle is extended further. Rather, it is the inner needle that has both first and second lengths, with the second being longer than the first.

Claim 14, the next independent claim, also claims that the helically wound wire member has a portion attached to the stylet and that the inner hollow needle is attached to the stylet as well. That is also the case for independent claim 27.

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The remaining claims, which depend from these three independent claims, claim other features that are not shown by the '162 patent or which are allowable since they depend from allowable claims.

Withdrawal of the forgoing rejection is respectfully requested.

Claims 13 and 18 were rejected under 35 U.S.C. § 103 over the '162 patent and Haaga, USP 5,394,887. Haaga was cited to show use of a side trocar edge, but both claims 13 and 18 depend from what is believed to be an allowable claim and are, therefore, also deemed to be allowable. Notice thereof is also respectfully requested.


Claims 10, 11, 25, 26, and 32 were rejected under 35 U.S.C. § 103 over the '162 patent and Dr. Wang's other patent USP 4,532,935. Claims 10, 11, 25 and 26 have been cancelled thus mooted their rejection. Claim 32 depends from what is believed to be an allowable claim and is, therefore, also deemed to be allowable. Notice thereof is also respectfully requested.

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Since all of the outstanding rejections and objections have been overcome, it is believed that this application is now in allowable condition and notice thereof is respectfully requested.

Respectfully submitted,

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